

REMARKS

This communication is a full and timely response to the aforementioned final Office Action dated September 8, 2006. By this communication, claims 1, 2 and 8 have been amended. Support for the subject matter recited in claim 1 can be found variously throughout the Specification, for example, at paragraphs 73 and 75.

Claims 1-16 remain pending.

Rejections Under 35 U.S.C. §112

Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended claim 1 to address the Examiner's concerns, and thus request that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-13 were rejected under 35 U.S.C. §103(a) as unpatentable over *Utsunomiya* (U.S. Patent No. 6,999,186) in view of *Terajima* (U.S. Patent No. 5,309,251). Applicants respectfully traverse this rejection.

The claimed invention is directed to an apparatus that prints multiple copies of a print job based on the results of detecting whether an expansion memory is mounted. Independent claim 1 recites, among other elements, that if an expansion memory is mounted, a controller stores processed job data in a first storage destination memory for a second output session and beyond, and if the expansion memory is not mounted, the controller stores the input job image data in a second storage destination memory for a second output session and beyond.

The *Utsunomiya* patent discloses two methods of printing a plurality of copies of a given print job. In the first method, the print data for one job is stored in an

input-output buffer. The print data is read out from the buffer, and an image is output for each desired copy. This process is repeated based on the number of copies to be printed. In a second method, rasterized image data for one job is stored in the rasterized image storage area, and a process for outputting image data from the rasterized image storage area is executed for each copy. This process is repeated in relation to the number of copies to be printed. The *Utsunomiya* patent fails to teach or suggest a controller that stores job image data in either a first or second destination memory based on the detection of an expansion memory. The Office Action relies on the *Terajima* patent to allegedly remedy this deficiency.

The *Terajima* patent discloses a facsimile apparatus that enables an external memory to be detachably loaded. When a sensor detects that the external memory is loaded, a received communication is stored in the external memory. Alternatively, when the sensor detects that the external memory is not loaded, the communication result is stored in a RAM of the main body. If an external memory is later loaded through the main body, the communication result stored in the RAM is then copied to the external memory. The communication result as disclosed in the *Terajima* patent includes information, such as, the telephone number and name of the communication partner, ID information, start time, communication time, number of sheets, the communication status, and any charge for the communication.

In response to the previous rejection, Applicants argued that outside of an improper reliance on Applicants' own disclosure, there is no indication that the features of the *Terajima* patent can be successfully substituted or integrated into the system of the *Utsunomiya* patent to achieve the claimed results. (See Applicants' Amendment filed on July 12, 2006).

In numbered paragraph 2 of the current Office Action, the Patent Office responds to this argument by merely inferring that the rejection takes into account only knowledge that was within the level of one with ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned from the Applicants' disclosure. While the *Terajima* patent may disclose the use of a sensor to detect the presence of an expansion memory, there is no teaching or suggestion that one of ordinary skill in the art would appreciate the use of this expansion memory as recited in the claims. Stated differently, the Patent Office has not shown that one of ordinary skill in the art would use the expansion memory to store image data in the manner performed by the claimed controller. Based on the combined teachings of the *Terajima* and *Utsunomiya* patents, one of ordinary skill in the art would arguably only use this additional memory to store transaction data.

In summary, the *Terajima* and *Utsunomiya* patents, either singularly or combined, fail to disclose or suggest a controller as recited in independent claims 1 and 8. For these reasons, Applicants submit that a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Applicants request, therefore, that independent claims 1 and 8 and their

corresponding dependent claims be allowed and the rejection under 35 U.S.C. §103 be withdrawn.

Claims 14-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Utsunomiya* in view of *Kisaki* (U.S. Pub. No. 2003/0035142) and in further view of the *Terajima* patent. Applicants respectfully traverse this rejection.

The Office Action acknowledges that the *Terajima* and *Utsunomiya* patents fail to disclose a controller as recited in claim 14 and relies on the *Kisaki* publication to remedy this deficiency. Particularly, the Office Action alleges that the *Kisaki* publication teaches a controller that prints a first copy and second copy onward as recited in the claim. Even if the interpretation of the *Kisaki* patent is accurate, which Applicants do not acquiesce that it is, these teachings still do not remedy the deficiencies of the *Terajima* and *Utsunomiya* patents concerning the storage of image data in either the expansion memory or work memory based on the detection of the expansion memory. For at least these reasons, Applicants submit that a *prima facie* case of obviousness has not been established with respect to claim 14, and request that the rejection of this claim and its depending claims be withdrawn.

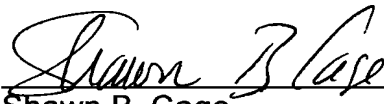
Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1-16 are allowable, and this application is in condition for allowance. In the event the instant application can be placed in even better form, Applicants request that the undersigned attorney be contacted at the number below.

Respectfully submitted,

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